

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Stephens	)
		)
For:	Location-Based Mobile Service	)
	Provision	)
		)
Serial No.:	10/539,849	)
		)
Filing Date:	December 5, 2003	)
		)
371(c) Date:	June 20, 2005	)
		)
Examiner:	Karikari, K.	)
		)
Art Unit:	2617	)

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

**APPELLANTS' BRIEF**

This brief is in furtherance of the NOTICE OF APPEAL, mailed on August 27, 2007.

Any fees required under 37 C.F.R. §41.20, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37(c)):

- I REAL PARTY IN INTEREST
- II RELATED APPEALS AND INTERFERENCES
- III STATUS OF CLAIMS
- IV STATUS OF AMENDMENTS

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### **I. REAL PARTY IN INTEREST**

The real party in interest in this appeal is Motorola, Inc., a Delaware corporation.

### **II. RELATED APPEALS AND INTERFERENCES**

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

### **III. STATUS OF CLAIMS**

#### **A. Status of all claims in the proceeding**

- |    |                     |       |
|----|---------------------|-------|
| 1. | Claims rejected:    | 32-55 |
| 2. | Claims allowed:     | none  |
| 3. | Claims withdrawn:   | none  |
| 4. | Claims objected to: | none  |
| 5. | Claims cancelled:   | 1-31  |

#### **B. Identification of claims being appealed**

The claims on appeal are: 32-55

#### **IV. STATUS OF AMENDMENTS**

No Amendments have been filed subsequent to the recent final rejection, dated April 27, 2007.

#### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention (claim 32) pertains to a method of providing location based services by a mobile service provider using a wireless communication system that facilitates communication with a plurality of communication units. The method includes providing (220) location information (page 11, line 32 to page 12, line 2), via a mobile communication unit adapted for use by the mobile service provider traveling to a previously undisclosed location where a service is to be performed (page 8, lines 19-25) of at least one of a current location of, and a location to be visited by, the mobile service provider to an intermediate device (page 10, lines 18-23). The transmission (240) of a wireless message is then initiated (page 9, lines 23-26; and page 10, lines 23-25) by the intermediate device in dependence on the location information provided by the mobile service provider (page 8, lines 27-33), to a number of communication devices in the at least one of the current location of, and the location to be visited by, the mobile service provider, wherein said wireless message indicates the service to be provided by said mobile service provider (page 12, lines 17-21) at the at least one of the current location of, and the location to be visited by, the mobile service provider (page 12, line 26 to page 13, line 10).

A further aspect of the present invention (claim 52), which is being appealed, pertains to a mobile communication unit for use by a mobile service provider. The mobile communication unit includes a processor (408), and a transmitter (422), which is operably coupled to and responsive to said processor (408). The processor (408) is configured to provide (220) location information (page 11, line 32 to page 12, line 2) of at least one of a current location of, and a location to be visited by, the mobile service provider traveling to a previously undisclosed location where a service is to be performed (page 8, lines 19-25) to initiate transmission (240) of a wireless message (page 9, lines 23-26; and page 10, lines 23-25) to a number of

communication devices in the at least one of the current location of, and the location to be visited by, the mobile service provider. The wireless message indicates the service to be provided by said mobile service provider (page 12, lines 17-21) at the at least one of the current location of, and the location to be visited by, the mobile service provider (page 12, line 26 to page 13, line 10).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Whether claims 32-55 have been improperly rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

2. Whether claims 32-47 and 49-55 have been improperly rejected under 35 U.S.C. 102(e) as being anticipated by Haddad et al., US Published Patent Application No. 2003/0137435.

3. Whether claim 48 has been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Haddad, '435, in view of Kinnunen et al., US Published Patent Application No. 2001/0018349.

## **VII. ARGUMENT**

### **A. Rejections under 35 U.S.C. 112**

1. Whether claims 32-55 have been improperly rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The Examiner continues to reject claims 32-55. More specifically, the Examiner has rejected claims 32-55 under 35 USC §112, first paragraph as failing to comply with the written description requirement (independent claims 32 and 52), or presumably as being dependent upon a claim that allegedly fails to comply with the written description requirement (dependent claims 33-51 and 53-55). However contrary to the Examiner's assertions, the specification satisfies the written description requirement, in so far as the specification reasonably conveys to one skilled in the art that the inventor, at the time the application was filed, had possession of the claimed

invention.

In alleging that the specification fails to comply with the written description requirement, the Examiner has appeared to focus on the amended claim feature - traveling to a previously (un?)disclosed location. The Examiner alleges that the specification fails to provide support for such a feature, as well as characterizes the feature as constituting new matter. However contrary to the Examiner's assertions, support for the feature "traveling to a previously undisclosed location" is provided, where the mobile service provider is characterized as "roaming" (see page 12, lines 17-24) and in the manner in which at least one example of a notification of an availability of a service at a respective location can be identified, where a cell broadcast can be made to a particular cell area when the service provider is in, or has indicated a subsequent visit to a cell area (see page 12, lines 30-34), and/or where the previously identified location (i.e. postcode) of the users having an interest in a particular service corresponds to the location (which in the particular embodiment is continuously updated) of the service provider as they move into, or approach a particular location (i.e. postcode) (see page 13, lines 1-10).

Roaming is defined by the American Heritage Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. 27 Aug. 2007. <Dictionary.com <http://dictionary.reference.com/browse/roaming>> as moving about without purpose or plan; (i.e. wander).

The Applicant's use of the phrase "roaming" in the specification as originally filed, effectively embodies the particular claim language in question, especially when considered in the full context of the entire specification.

While the Examiner may be seeking a showing where the exact language can be found in the specification as originally filed, such a requirement is misplaced, as there is no such requirement.

As articulated by the Federal Circuit, the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). It is well

settled, that a determination as to whether the originally filed disclosure of the application reasonably conveys to the artisan an indication that the inventor had possession of the claimed subject matter, does not require that the claimed subject matter be described identically. Precisely how close the original description must come in order to comply with the description requirement must be determined on a case-by-case basis. In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984) (emphasis added).

In the present instance, while the claimed subject matter is not described identically, there is no such requirement. Further, in view of at least the portions of the application noted above, one skilled in the art would understand that the inventors had possession of the later claimed subject matter, at the time the application was originally filed. Consequently, the corresponding rejection relative to independent claims 32 and 52, and the claims which depend therefrom, should be withdrawn.

#### **B. Rejections under 35 U.S.C. 102**

2. Whether claims 32-47 and 49-55 have been improperly rejected under 35 U.S.C. 102(e) as being anticipated by Haddad et al., US Published Patent Application No. 2003/0137435.

##### Claims 32-47 and 49-55

The Examiner further continues to reject claims 32-47 and 49-55 under 35 USC §102(e) as being anticipated by Haddad et al., US Published Patent Application No. 2003/0137435. However, contrary to the Examiner's assertions, the relied upon reference fails to make known each and every feature of the claims, and therefore cannot be said to make known the respective claims. Relative to the alleged anticipation of at least independent claims 32 and 52, contrary to the Examiner's assertion, Haddad et al., '435, fails to make known each and every feature of claims 32 and 52, and indirectly any of the claims, which depend therefrom. More specifically, as previously identified by the applicant, Haddad et al., '435, minimally fails to make known or obvious the feature of "the mobile service provider traveling to a previously undisclosed location

where a service is to be performed”. While the Examiner has attempted to identify a couple of passages from the cited reference, which allegedly make known or obvious such a feature, when one reviews the specific passages noted, the passages fail to teach or suggest the features they are alleged to make known. Taking each of the passages individually, the fact that each vehicle may have a route comprising a plurality of different stops [0035] is irrelevant, the path for each vehicle still defines a route, which generally defines “a customary or regular line of passage or travel”, and/or “a specific itinerary, round, or number of stops regularly visited by a person in the performance of his or her work” – see Dictionary.com Unabridged (v 1.1). Random House, Inc. 27 Aug. 2007. <Dictionary.com <http://dictionary.reference.com/browse/route>>. In other words, there is no suggestion that the locations are previously undisclosed, and in fact the alternative use of the term route, which generally corresponds to customary or regular line of passage or travel – speaks to the contrary.

The Examiner’s allegation that the specified location may not be predetermined referencing paragraph [0019], similarly cannot be supported, where the particular passage indicates that the specified location may be a predetermined, fixed, stopping point, or vehicle stop, for the vehicle, or alternatively the specified location may not be so predetermined, but could be a more variable predetermined specified location. In each instance the location is still identified as being predetermined. Furthermore, viewed in its full context, the paragraph refers to the type of stop (i.e. bus stop, train station, airport, taxi rank vs. any house or location to which a taxi is to arrive), and not whether the location was previously undisclosed. In fact, the very next paragraph clearly characterizes the corresponding event as an “expected” event [0020], not unlike the expected occurrence of an event [0009].

The Examiner’s further characterization, that a particular bus can be added or diverted to a particular route [0024], does not exclude the fact that the different vehicles and their corresponding location past, present and future is still associated with a particular route, and the corresponding locations along a particular route, upon association with that route. Lastly, paragraph [0047], while it suggests that a non-route fixed transport is possible, still characterizes the position and the particular pick up point of the vehicle as being known. While the Examiner has cited several different sections, none of the cited sections contradict the characterization of

the teachings from the cited reference as relating to an expected event and/or occurrence of an event [0009] and [0019], where the question concerning arrival is not if, but when. Furthermore, even with respect to when, the question is to whether the bus is arriving on schedule or how far off of schedule, such that the arrival is generally imminent relative to a predefined schedule and location, that might experience a small degree of deviation due to variances in travel time because of varying amounts of traffic, etc.

Furthermore, the service performed in the cited reference relates to transport services, which convey a person from one location to another, such that the service only begins or ends relative to a particular location, as opposed to a service being performed at a particular location, as provided by the claims.

As a result, contrary to the Examiner's assertions, the reference fails to teach or suggest a relationship relative to "a mobile service provider traveling to a previously undisclosed location where a service is to be performed". Correspondingly, contrary to the Examiner's assertions, the reference fails to make known or obvious each and every feature of the independent claims, and indirectly each of the claims which depend therefrom. Kimmunen et al., '349, fails to account for the above noted deficiencies of Haddad et al., '435.

### **C. Rejections under 35 U.S.C. 103**

3. Whether claim 48 has been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Haddad, '435, in view of Kinnunen et al., US Published Patent Application No. 2001/0018349.

#### Claim 48

The Examiner continues to reject claims 48 under 35 USC §103(a) as being unpatentable over Haddad et al., '435, in view of Kinnunen et al., US Published Patent Application No. 2001/0018349. However contrary to the Examiner's assertions, the combination of references fail to make known or obvious each and every feature of the claims. Claim 48, corresponds indirectly to independent claim 32, and is similarly allowable for the same reasons noted above



with respect to claim 32, and the corresponding discussion of the claimed method of providing location based services by a mobile service provider using a wireless communication system that facilitates communication with a plurality of communication units. The relative arguments with respect to claim 32, made above, are expressly incorporated herewith. In essence, to the extent that claim 32 is believed to neither be anticipated, nor obviated by the cited references, claims 48 is believed to similarly be neither anticipated, nor obviated. Furthermore, to the extent that the Examiner has further relied upon Kinnunen et al., '349, in support of the rejection, Kinnunen et al., '349, does not cure the above noted deficiencies relative to the Examiner's attempted application of Haddad et al., '435, to either claim 32 and/or intervening claim 37.

### Conclusion

In view of the above analysis, the applicants would assert, that the Examiner has failed to establish that any of the cited references either separately or in combination make known or obvious the presently pending claims. The applicants would respectfully request that the Examiner's decision to finally reject and/or object to the presently pending claims be overturned, and that the claims be permitted to proceed to allowance.

Respectfully submitted,

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## VIII

## APPENDIX OF CLAIMS

The following is the text of the claims involved in this appeal:

1-31. (canceled)

32. A method of providing location based services by a mobile service provider using a wireless communication system that facilitates communication with a plurality of communication units, the method comprising:

providing location information, via a mobile communication unit adapted for use by the mobile service provider traveling to a previously undisclosed location where a service is to be performed of at least one of a current location of, and a location to be visited by, the mobile service provider to an intermediate device; and

initiating the transmission of a wireless message, by the intermediate device in dependence on the location information provided by the mobile service provider, to a number of communication devices in the at least one of the current location of, and the location to be visited by, the mobile service provider, wherein said wireless message indicates the service to be provided by said mobile service provider at the at least one of the current location of, and the location to be visited by, the mobile service provider.

33. The method according to claim 32, wherein the initiating the transmission of a wireless message step comprises transmitting a wireless message to a number of communication devices in a predetermined location when the location information indicates the mobile service

provider has at least one of moved into and is approaching the predetermined location.

34. The method according to claim 32, further comprising:

registering an interest in said service by a number of communication devices; and  
identifying the communication devices that have registered an interest in said service and that are  
located in the at least one of the current location of, and the location to be visited by, the mobile  
service provider, such that said wireless message is transmitted to said communication devices.

35. The method according to claim 34, wherein registering an interest in said service  
by said number of communication devices is specific to at least one of a particular geographic  
location and a location identified by a postcode.

36. The method according to claim 32, wherein said wireless message includes  
contact details for said mobile service provider, the method further comprising:  
receiving said wireless message at a number of communication devices; and  
contacting, by one or more users of said communication devices, said mobile service  
provider in response to receiving said wireless message.

37. The method according to claim 32, further comprising:

broadcasting, by said intermediate device, a message to said number of communication  
units within a location area indicating an availability of said mobile service provider.

38. The method according to claim 34, further comprising:  
accessing a database, by said intermediate device, to identify a group of users that have registered an interest in said service provided by said mobile service provider.

39. The method according to claim 38, wherein said database contains location information for a number of said users such that one or more of said user are informed by said intermediate device when said mobile service provider enters at least one of a communication cell, a geographic area, and a post code area matching said location.

40. The method according to claim 34, wherein registering an interest in said service comprises:

subscribing, by a user interested in said service provided by said mobile service provider, to at least one of a network operator and a wireless service provider operating said intermediate device, such that information relating to said service is communicated to said subscribed user.

41. The method according to claim 32, further comprising:  
accessing a database, by said mobile service provider, wherein said database identifies a group of users in a location that have registered an interest in said service provided by said mobile service provider;

downloading a list of said group of users;

moving into said location by said mobile service provider; and

transmitting a wireless message to a number of said group of users directly by said

mobile service provider based on said downloaded list.

42. The method according to claim 32, the method further comprising:

polling a number of communication devices in at least one of the same geographic area and cell where said mobile service provider is located to determine whether any of said polled communication devices have registered an interest to use a service offered by said mobile service provider.

43. The method according to claim 32, further comprising:

notifying said number of communication devices in a location of at least one of an event and an availability of said service at said location, via a short message service (SMS) message.

44. The method according to claim 32, wherein the transmission of a wireless message to a number of communication devices is sent at least one of:

- (i) intermittently,
- (ii) periodically, and
- (iii) during low traffic periods to utilize less expensive calling rates.

45. The method according to claim 37, wherein broadcasting a message of said availability of said mobile service provider (112) is sent at least one of:

- (i) intermittently,
- (ii) periodically, and

(iii) during low traffic periods to utilize less expensive calling rates.

46. The method according to claim 37, wherein the transmission of a wireless message is sent on the same wireless communication system, as said step of broadcasting a message of said availability.

47. The method according to claim 37, wherein broadcasting a message of said availability is sent on an adjunct communication system to the communication system facilitating the transmission of a wireless message.

48. The method according to claim 37, wherein at least one of said intermediate device, and a device operably coupled thereto, authenticates said mobile service provider prior to broadcasting said service of said mobile service provider.

49. The method according to claim 32, wherein providing location based services by a mobile service provider using a wireless communication system that facilitates communication is implemented at least in part using a storage medium storing processor-implementable instructions adapted to control a processor.

50. The method according to claim 32, wherein the wireless communication system is one of a UMTS communication system, a GSM communication system, a GPRS communication system, and a Bluetooth communication system.

51. The method according to claim 32, wherein the mobile communication unit of the mobile service provider is one of: a cellular phone, a portable radio, a mobile radio, a personal digital assistant, a laptop computer, and a wirelessly networked PC.

52. A mobile communication unit for use by a mobile service provider, comprising:  
a processor; and  
a transmitter, operably coupled to and responsive to said processor, wherein said processor is configured to provide location information of at least one of a current location of, and a location to be visited by, the mobile service provider traveling to a previously undisclosed location where a service is to be performed to initiate transmission of a wireless message to a number of communication devices in the at least one of the current location of, and the location to be visited by, the mobile service provider, and wherein said wireless message indicates the service to be provided by said mobile service provider at the at least one of the current location of, and the location to be visited by, the mobile service provider.

53. The mobile communication unit according to claim 52, wherein said mobile communication unit is adapted to function as a mobile service provider advertising device and said wireless message includes one or more of the following: mobile service provider contact details, a service provided/offered by a user of the mobile communication unit, a communication cell or geographical location of, or to be visited by, the mobile communication unit.

54. The mobile communication unit according to claim 52, the mobile communication unit further comprising a receiver and a memory unit, operably coupled to said processor, said receiver arranged to receive a list of subscriber groups that have registered an interest in the service offered by the mobile service provider in a particular geographic area or communication cell, and said memory unit is configured to store said received list.

55. The communication unit according to any of claim 52, wherein the communication unit is one of: a cellular phone, a portable radio, a mobile radio, a personal digital assistant, a laptop computer, and a wirelessly networked PC.



## **IX EVIDENCE APPENDIX**

None

**X      RELATED PROCEEDINGS APPENDIX**

None